

**REMARKS**

In the outstanding Office Action, the specification was objected to under 35 U.S.C. § 132 for introducing new subject matter; claims 158-163 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement; and claims 1-7 and 120-157 were rejected under 35 U.S.C. § 102(b) as anticipated by at least one of U.S. Patent Nos. 4,346,869 to MacNeill, 4,188,953 to Klieman et al., 4,424,810 to Jewusiak, and 4,449,531 to Cerwin et al.

By this Response, Applicants have amended claims 1, 120, 135, and 148, and have added new claims 164-167. Accordingly, claims 1-7 and 120-167 are pending in this application. No new matter has been added by this Response.

Applicants respectfully traverse the rejection of claims 158-163 under 35 U.S.C. § 112, first paragraph, and the corresponding objection to the specification. Support for the “bridge connecting said first and second arms” recited in claims 158 and 162 can be found, for example, in the clip 300 illustrated in Fig. 6A of the present application. A “bridge” may be defined as “a time, place, or means of connection or transition.” *Merriam-Webster’s Collegiate Dictionary* 142 (10<sup>th</sup> ed. 2001) As shown in Fig. 6A of the present application, the clip 300 includes a base portion at a proximal end of each of the arms 301, 302. This base portion or “bridge” serves to connect the two arms together. Thus, Applicants submit that one of ordinary skill in the art would recognize that the originally filed application supports the bridge connecting the first and second arms recited in independent claims 158 and 162. For at least this reason, Applicants request reconsideration and withdrawal of this portion of the outstanding 35 U.S.C. § 112, first paragraph, rejection and the associated specification objection.

Applicants also disagree that the “structure adapted to prevent rotation of the clip about a longitudinal axis of the clip” recited in claims 160 and 162 lacks adequate written description and introduces new matter to the specification. Support for this claimed structure can be found, for example, in the barbs 304 of the clip 300 illustrated in Fig. 6A of the originally filed application. Paragraph no. 74 of the originally filed application states that “[b]arbs 304 help to prevent the clip from moving relative to the tissue fold and assist in holding tissue clip 300 in place should the frictional engagement between the clip and the fold be overcome.” See also the second to last sentence of paragraph no. 77 of the present application. This stated prevention of movement includes rotation of the clip. Accordingly, Applicant’s submit that one of ordinary skill in the art would recognize that the originally filed application supports the structure adapted to prevent rotation of the clip recited in claims 160 and 162. For at least this reason, Applicants request reconsideration and withdrawal of this portion of the outstanding 35 U.S.C. § 112, first paragraph, rejection and the associated specification objection.

Applicants also respectfully traverse the rejections of claims 1-7 and 120-157 under 35 U.S.C. § 102(b). The cited patents to MacNeill, Klieman et al., Jewusiak, and Cerwin et al. all fail to disclose or suggest the devices recited in independent claims 1, 120, 135, and 148. For example, MacNeill, Jewusiak, and Cerwin et al. each fails to disclose or suggest, among other things, a device for securing a fold of tissue that includes a first arm and a second arm configured to extend in substantially the same direction as the fold of tissue. Each of the devices of MacNeill, Jewusiak, and Cerwin et al. is configured to clamp tubular structures between the proximal and distal ends of

their respective arms. See, for example, Fig. 4 of MacNeill, Fig. 2 of Jewusiak, and Fig. 3 of Cerwin et al. MacNeill, Jewusiak, and Cerwin et al. do not disclose securing a fold of tissue, nor do these patents disclose arms configured to extend substantially in the same direction as a fold of tissue. In fact, the configurations of the distally located locking members disclosed in each of MacNeill, Jewusiak, and Cerwin et al. teach away from securing a fold of tissue with arms configured to extend substantially in the same direction as the fold of tissue. This distinction is clear when comparing Fig. 7 of the present application to Figs. 4, 2, and 3 of the MacNeill, Jewusiak, and Cerwin et al. patents, respectively.

With respect to the Klieman et al. patent, Klieman et al. discloses a hemostatic clip for strangulation of tubular members including arms having inner surfaces that are brought into contact with one another. See the Abstract of Klieman et al. Similar to the MacNeill, Jewusiak, and Cerwin et al. patents, Klieman et al. fails to disclose or suggest, among other things, a device for securing a fold of tissue that includes a first arm and a second arm configured to extend in substantially the same direction as the fold of tissue, as recited in independent claims 1 and 120. Klieman et al. does not disclose securing a fold of tissue, nor does Klieman et al. disclose arms configured to extend substantially in the same direction as a fold of tissue. In fact, Klieman et al. appears to teach away from such capability by stating that the opposing inner surfaces of the disclosed clip are brought into contact with one another. This distinction is clear when comparing Fig. 7 of the present application to Fig. 2 of Klieman et al.

For at least the above reasons, Applicants respectfully request reconsideration of the 35 U.S.C. § 102(b) rejections of independent claims 1, 120, 135, and 148 in view of MacNeill, Klieman et al., Jewusiak, and Cerwin et al.

Claims 2-7, 121-134, 136-147, 149-157, and 164-167 all depend from one of independent claims 1, 120, 135, and 148, and are therefore allowable for at least the same reasons provided above that independent claims 1, 120, 135, and 148 are allowable. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each also are separately patentable.

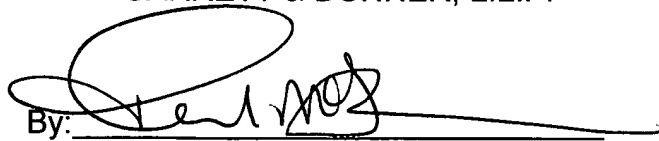
The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

If there is any fee due in connection with the filing of this Response that is not otherwise provided with the filing, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: September 10, 2004

By:   
Roland G. McAndrews  
Reg. No. 41,450